

## **REMARKS**

Claims 1-4, 6-12 and 14-16 are now present in the instance application. In the most recent Office Action, claims 1-4, 6-7, 9-12 and 15-16 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,535,275 to Sugisaki, et al. (hereinafter, "Sugisaki"). Claims 5, 8, 13 and 16 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Sugisaki in view of U.S. Patent No. 5,991,403 to Aucsmith, et al. (hereinafter, "Aucsmith").

As amended above, claims 1 and 9 include subject matter recited in claims 5 and 13, respectively, previously dependent from claims 1 and 9. Claims 5 and 13 are cancelled. No new matter has been added by the amendment.

In the Office Action, claims 5, 8, 13 and 16 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,535,275 to Sugisaki, et al. (hereinafter, "Sugisaki") in view of U.S. Patent No. 5,991,403 to Aucsmith, et al. (hereinafter, "Aucsmith"). Applicant respectfully traverses, for at least the following reasons.

Claim 1, as amended, recites an apparatus for controlling image quality reduction of image information comprising, a reverse section for reversing a specific code by means of a code stream of said image information, and outputting it after reducing image quality of said image information by means of reverse of one code or a plurality of codes, wherein said reverse section specifies a reverse position by means of coordinates within each unit block of image information. Similarly, claim 9 recites a method of controlling image quality reduction of image information comprising, reversing a specific code by means of a code stream of said image information, and outputting it after reducing image quality of said image information by means of reverse of one

code or a plurality of codes, wherein said reverse step includes a step of specifying a reverse position by means of coordinates within each unit block of image information.

The Office Action admits that Sugisaki does not teach these features. The Office Action offers Aucsmith as teaching a synchronized rotation transformation as means of data encryption ("scrambling" in the Office Action), and that the re-conversion is accomplished by inverting the rotation of the reference coordinate axes. The Office Action avers that it would have been obvious to combine Sugisaki and Aucsmith to achieve the claimed invention. Applicant respectfully disagrees.

It has been held by the courts that to establish prima facie obviousness, there must be some suggestion or motivation to modify the reference. *See, In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. *See, Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). "The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence." *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir. 2002) (Citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

In this case, the Office Action avers that the rotational transformation disclosed in Aucsmith "[P]rovides the desirable advantage of showing an alternate scrambling technique." (Office Action, p. 6) In fact, the desirability of this or any other alternate scrambling technique is merely presumed. The fact that an alternate scrambling technique exists does not motivate one skilled in the art to chose the particular scrambling technique of Aucsmith. Therefore, due to the

lack of such a clear and particular motivation to combine, Applicant respectfully submits that the rejection is poorly taken, and kindly requests that it be reconsidered and withdrawn.

Even assuming, *arguendo*, that there were some motivation to combine the references, the combination of Sugisaki and Aucsmith still does not reach the claimed invention. As recited in the claims, the reverse section specifies a reverse position by means of coordinates within each unit block of image information. In the first instance, the rotational transformation method of Aucsmith is not dependent upon coordinates within each unit block of image information. Rather, it is applied indiscriminately to all image information. Further, in contrast to the claimed invention, the cited section of Aucsmith discusses the encryption and decryption of image data by application of a rotational transform and an inversion of the rotational transform. There is no discussion of a reversal of any kind. The distinction between a reversal of image data codes as recited in the claim, and an inversion of a rotational (or any other, for that matter) transformation will be apparent to one skilled in the art. Therefore, the cited portion of Aucsmith does not teach what is attributed to it.

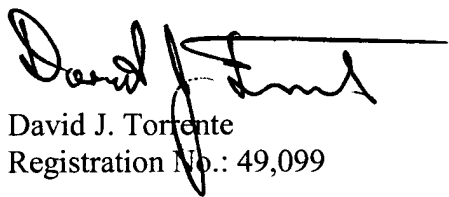
It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, because the neither Sugisaki, nor Aucsmith, taken alone or in any combination, teaches or suggest all limitation of claims 1 and 9, Applicant respectfully submits that these claims are patentably distinguished over the prior art.

Claims 2-4, 6-8 and 10-12, 14-16 each depend from claims 1 and 9, respectively. These dependent claims are each separately patentable, but are offered as patentable for at least the same reasons as their underlying base claims. Therefore, Applicant kindly requests favorable reconsideration and withdrawal of the rejection of all claims.

In the interest of brevity, Applicant has addressed only so much of the rejection(s) as is considered sufficient to demonstrate the patentability of the claim(s). Applicant's failure to address any part of the rejection should not be construed as acquiescence in the propriety of such portions not addressed. Applicant maintains that the claims are patentable for reasons other than these specifically discussed, *supra*.

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter, and kindly solicits an early indication of allowability of all claims. If the Examiner has any reservations in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at an earliest convenience.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "David J. Torrente", with a long horizontal line extending to the right.

David J. Torrente  
Registration No.: 49,099

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343